IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/667,366	**Conf. No.:** 9751
Filing Date: 09/22/2000	**Art Unit:** 2134
Applicant: Ling et al.	**Examiner:** Ho, Thomas M.
Title: METHOD FOR PREVENTING PARASITIC USAGE OF WEB PAGE EMBEDDED FILES	**Docket No.:** GB919990146US1

COMMISSIONER FOR PATENTS

DESTINATION FACSIMILE NUMBER: 703-872-9306

Transmitted herewith is: **Amendment in 9 pages**

in the above identified application.

☒ No additional fee is required.

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Ronald A. D'Alessandro, Reg. No. 42,456

DATE: June 4, 2004

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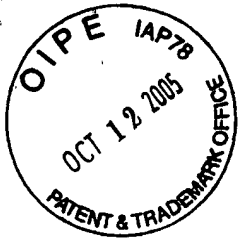
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Ling *et al.*   Conf. No.:   9751

Serial No.:   09/667,366   Art Unit: 2134

Filed: 09/22/2000   Examiner: Ho, Thomas M.

Title: METHOD FOR PREVENTING   Docket. No.:   GB9-1999-0146US1 (IBMR-0077)
        PARASITIC USAGE OF
        WEB PAGE EMBEDDED FILES

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

Sir:

I. INTRODUCTORY COMMENTS:

This paper is being filed in response to the Office Action dated March 4, 2004. Please

amend the above-referenced patent application as follows:

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this

paper.

Remarks begin on page 6 of this paper.

AMENDMENTS TO THE CLAIMS

The following listing of claims replaces all prior versions, and listings, of claims in the application:

1. (Currently Amended) A method of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

responsive to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server;

responsive to a request from a client for an element of a ~~a~~ said web page that is displayed as an embedded element of said web page, checking for said indicator that said client has requested a ~~a~~ said web page from said web server; and

responding to the request from the client for said element of a ~~a~~ said web page hosted by the web server according to the result of said checking step.

2. (Previously Presented) The method as claimed in claim 1, wherein said storing step comprises:

returning to the client a persistent client state object having an identifier therein; and

wherein said checking step comprises checking for said persistent client state object having the identifier therein returned by said client, prior to said responding step.

3. (Previously Presented) The method as claimed in claim 2 wherein the persistent client state object is a cookie.

4. (Previously Presented) The method as claimed in claim 2 wherein the persistent client state object expires after a pre-determined period of time.

5. (Previously Presented) The method as claimed in claim 1 wherein said storing step comprises adding an identity of said client to a table associated with said web server; and wherein said checking step comprises checking for said client identity in said table, prior to said responding step.

6. (Previously Presented) The method as claimed in claim 1 wherein said table includes an expiration time associated with a respective client identity in said table.

7. (Currently Amended) A method of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

responsive to a request from a client for an element of a web page that is displayed as an embedded element of said web page, checking said request for an indicator that said request results from a client request for a web page hosted by an authorised web server; and

responsive to the presence of such an indicator, responding to the request from the client with said element of a web page.

8. (Previously Presented) The method as claimed in claim 7 wherein said indicator comprises a Uniform Resource Locator (URL) for said web page, and said checking step comprises checking that said web page URL is from an authorised web server.

9. (Previously Presented) The method as claimed in claim 7 wherein said indicator comprises a meta-tag incorporated in web pages from authorised servers, and said checking step comprises checking that said meta-tag is from an authorised web server.

10. (Previously Presented) The method as claimed in claim 9 wherein said meta-tag is a PICS compliant tag.

11. (Previously Presented) The method as claimed in claim 7 operable in one of: said web server or a proxy server connecting said web client to said web server.

12. (Previously Presented) The method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning a message for display at the client to the client.

13. (Previously Presented) The method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning a substitute element to the client.

14. (Previously Presented) The method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning no response to the client.

15. (Currently Amended) In a web client, a method of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

responsive to encountering a request for an element of a web page that is displayed as an embedded element of said web page, checking that said request results from a client request for a web page hosted by an authorised web server; and

responsive to such a request, requesting said web page element from a server hosting said web page element.

16. (Previously Presented) A computer program product for verifying a right to use an element of a web page, the computer program product comprising:

a computer-readable storage medium having a substrate; and

program data encoded in the substrate of the computer-readable storage medium, wherein the program data comprises means for performing the steps of claim 1, claim 7 or claim 15.

17. (Original) A computer program comprising computer program code means adapted to perform all the steps of any one of claims 1 to 15 when said program is run on a computer.

18. (Previously Presented) The method as claimed in claim 1, wherein if said checking step fails to detect said indicator, said responding step comprises returning a message for display at the client to the client.

19. (Previously Presented) The method as claimed in claim 1, wherein if said checking step fails to detect said indicator, said responding step comprises returning a substitute element to the client.

20. (Previously Presented) The method as claimed in claim 1, wherein if said checking step fails to detect said indicator, said responding step comprises returning no response to the client.

II. REMARKS

Claims 1-20 are pending in this application. By this amendment, claims 1, 7, and 15 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-8, 11-13, 15-16, and 18-19 are rejected under 35 U.S.C. §102(b) as being anticipated by Shi et al. (US patent no 5,875,296), hereafter "Shi." Claims 9-10, 14, 17, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shi. This rejection is respectfully traversed for the reasons stated below.

A. REJECTION OF CLAIMS 1-8, 11-13, 15-16, AND 18-19 UNDER 35 U.S.C. § 102(b)

In the Office Action, claims 1-8, 11-13, 15-16 and 18-19 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Shi et al. (US patent no 5,875,296), hereafter Shi. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); see MPEP § 2131, p. 2100-70. Applicants respectfully submit that Shi does not teach each and every feature of the claimed invention.

Specifically, applicants respectfully submit that Shi fails to disclose an element of a web page that is an embedded element of said web page. The Office incorrectly equates the file in a

Distributed Computing Environment (DCE) of Shi with the element of a web page that is displayed as an embedded element of said web page as included in the present invention. The DCE environment in Shi is a file server environment in which multiple users access resources and process applications in a distributed environment. Col. 1, line 26-33. The DCE environment in Shi has a robust security mechanism to prevent unauthorized access to the network resources. Col. 1, line 39-42. As a result, all files in a DCE system as used in Shi are protected against unauthorized use. Conversely, the verification method as claimed in the present invention verifies that a parent web site has been accessed before it will allow access to the embedded child web site. This is clearly not equivalent to the verification in Shi, where the authorization to use a file is not dependent upon whether a specific parent file has been previously accessed. Accordingly, Applicants request that the rejection be withdrawn.

Furthermore, the Office is in error in stating that Shi discloses storing an indicator in response to a request from a client for a web page hosted by a web server. In Shi, the indicator is stored only after a user has logged in to the network. Col. 8, line 32-46. FIG. 4. The authentication method in Shi requires a user to log in using a user id and password before the user can get any data from the system. Col. 8, line 47-51. Shi does not disclose a verification method in which no initial login occurs. Conversely, in order to access the element of a web page as included in the present invention, a user must access the web page into which the element is embedded. The login in Shi is clearly not equivalent to the step of accessing a parent web page as provided in the present invention. Accordingly, Applicants respectfully request that the Office withdraw its rejection.
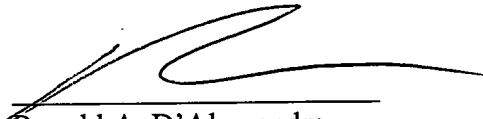
B. REJECTION OF CLAIMS 9, 10, 14, 17, and 20 UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 9, 10, 14, 17, and 20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shi. Applicants herein incorporate the arguments presented above with respect to independent claims 1, 7, and 15 from which claims 9, 10, 14, 17, and 20 depend. In particular, since Shi does not teach all the claim limitations of claim 1, 7, and 15, Shi also fails to teach all the limitations of the dependent claims 9, 10, 14, 17, and 20. As a result, Applicants respectfully request withdrawal of this rejection.

III. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, he is requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Date: June 4, 2004

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